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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,669	09/20/2000	Thomas G. Woolston	99892	5562

20985 7590 09/30/2003

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SAN DIEGO, CA 92122

EXAMINER

SAGER, MARK ALAN

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 09/30/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/665,669

Applicant(s)

Woolston

Examiner

Sager

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 5/08/2003; 5/23/2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-69, 71-79, 81, 82, and 94-106 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-69, 71-79, 81, 82, and 94-106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 84-93 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the software, embodied in a form understandable by a programmable controller, for causing the programmable controller to control an electronic game, as claimed, appears to be form of either a signal or software [code] or software programming language [eg. Fortran, Assembler, Pascal, PL/1, etc.] that is not embodied on a computer readable medium readable by or implemented in a processing device which is non-statutory subject matter. Essentially, the language is non-statutory due to the non-functional descriptive material not being embodied on a readable medium and thus lacks producing a concrete, tangible or useful result therefrom. See *State Street*, 149 F.3d at 1374-1375, 47 USPQ 2d at 1602. See *AT&T Corp. V. Excel Comm. Inc.*, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). Further, software per se is non-statutory. The PTO web site at <http://www.uspto.gov/web/patents/guides.htm> provides guidance for claiming inventions relating to program code in Examination Guidelines for Computer-Related Inventions & Training Materials.

***Double Patenting***

3. Claim 20-69, 71-79, 81-82, 84-106 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6162123. Although the conflicting claims are not identical, they are not patentably distinct from

each other because it would have been obvious to claim the method or apparatus broader in order to obtain the most commercially viable form of invention or in order to obtain the broadest protection for invention for securing commercial viability. Essentially, the omitted language limited the invention and thus by omitting the language, a broader form of invention is claimed which secures broader protection for commercial viability. Additionally, connecting multiple game players together in a computer network to play is obvious for permitting group [remote] play so as to increase enjoyment or to increase availability of competition play. Also, instant claimed forms of invention [system, method, apparatus, software in a form (i.e. whereby the software is embodied on a computer readable medium)] are obvious forms of apparatus and method of cited patent to provide protection for all marketable forms of use.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 84-93 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase 'in the form of' is indefinite or vague since it is unclear as to how this modifies software.

***Response to Arguments***

6. Applicant's arguments filed May 8, 2003 and May 23, 2003 have been fully considered but they are not persuasive. Judicially created obvious double patenting is maintained herein from prior action. Also, the examiner has reconsidered the scope of invention involving claims 84-93

and has determined them to be non-statutory as presently claimed. Essentially, patentable subject matter has been noted within specification (pre parent patent); however, cited claims appear non-statutory as presently claimed.

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Valencia Martin Wallace, can be reached on (703) 308-4119. The fax phone number for this Group is (703) 872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



M. Sager  
Primary Examiner  
Sep. 23, 2003